

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 020366-067210US	
I hereby certify that this correspondence is being filed via EFS-Web with the United States Patent and Trademark Office on <u>December 5, 2008</u> . TOWNSEND and TOWNSEND and CREW LLP By: <u>/Tara N. Damhoff/</u> Tara N. Damhoff		Application Number 10/601,773	Filed June 23, 2003
		First Named Inventor Edward A. Youngs	
		Art Unit 2617	Examiner: Manoharan, Muthuswamy Ganapathy
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between;"> <div style="width: 45%;"> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>54,544</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> </div> <div style="width: 45%; text-align: center;"> <p><u>/Tadd F. Wilson/</u></p> <p>Signature</p> <p><u>Tadd F. Wilson</u></p> <p>Typed or printed name</p> <p><u>303-571-4000</u></p> <p>Telephone number</p> <p><u>December 5, 2008</u></p> <p>Date</p> </div> </div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			

☐ *Total of _____ form is submitted.

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PATENT
Attorney Docket No.: 020366-067210US

TOWNSEND and TOWNSEND and CREW LLP

By: /Tara N. Damhoff/
Tara N. Damhoff

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Edward A. Youngs, et al.

Application No.: 10/601,773

Filed: June 23, 2003

For: METHOD AND SYSTEM FOR
PROVIDING TRANSMISSION
OF SELECTED MEDIA
PROGRAMS TO A WIRELESS
SUBSCRIBER

Customer No.: 20350

Confirmation No.: 9495

Examiner: Manoharan, Muthuswamy
Ganapathy

Art Unit: 2617

PRE-APPEAL BRIEF REQUEST FOR
REVIEW

MAIL STOP: AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejections dated September 5, 2008 (the "Office Action") for the above-identified application. A Request For Reconsideration has been filed in this application, but no amendments were made in that response, and none have been entered after-final. An Advisory Action was later issued on the above-identified application on November 19, 2008 (the "Advisory Action"). No amendments to the claims are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated herein.

REMARKS/ARGUMENTS

Reasons for Appeal:

1. Whether a prima facie case of obviousness is asserted by the Examiner when the cited art fails to teach the claim limitations:

2. Whether the cited art inherently teaches the claim elements without the proper justification from the Examiner:

Claims 30-34, 39-40, 42 and 44-49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,169,894 B1 to McCormick et al. ("McCormick") in view of U.S. Patent No. 5,200,954 to Tecl, Jr. et al. ("Tecl").

The cited references do not teach or suggest all the claims elements, and the record has not established that all claim elements can be found in the prior art. Specifically, the cited references do not teach or suggest, "establishing a second wireless channel upon which to broadcast the selected media program to the second wireless handset if the second wireless handset is determined to be outside the cell site coverage area, wherein the second wireless channel is different than the first wireless channel" as recited in claim 30. Claim 40 includes a similar element.

In its immediately prior response, the Applicants successfully argued that the cited references do not teach or suggest this. The pending Office Action appears to concede this, arguing now that this element "is not very critical and is clearly a design choice." The office action supports this assertion with reference to the Applicant's disclosure, wherein the recited element is discussed as an item in a flow chart. The Applicants respectfully point out, however, that teaching multiple embodiments in the Detailed Description of the specification IS NOT evidence of mere design choice. More directly, it is not within the purview of the Examiner to dismiss patentable features as mere design choice. Regardless, the Examiner has failed to cite any portion of a reference teaching this element of the claims. As such, the Examiner has not proven the application unpatentable.

Accordingly, independent claims 30 and 40, and all remaining claims that depend from them, recite features that are not taught or suggested by the cited references and have not

been shown to exist in the prior art. All pending claims are, therefore, believed to be allowable, at least for this reason.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

Respectfully submitted,

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